



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,587	12/18/2001	Kurt C. Melancon	55468US002	1248

32692 7590 01/28/2003

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
----------	--------------

1712


DATE MAILED: 01/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary

Application No. 10/027,587	Applicant(s) Melancon et al.	
Examiner Christopher M. Keehan	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 18, 2001 and Apr 30, 2002
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-24, 27-34, 37-41, 44-48, and 52-63 is/are rejected.
- 7) ☒ Claim(s) 3-7, 25, 26, 35, 36, 42, 43, and 49-51 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

DETAILED ACTION***El ction/Restrictions***

Note: the Examiner called David Pastirik on 12/20/02 regarding a restriction requirement, and Applicant elected Group I, claims 1-28 and 58-63, with traverse. However, upon looking again at the dependency of the claims, it appears a restriction requirement is inappropriate. Therefore, all the claims in the application have been examined and the restriction requirement is withdrawn.

Allowable Subject Matter

Claims 3-7, 25, 26, 35, 36, 42, 43, and 49-51, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 3-7, 25, and 26, Sherman et al. disclose similar tests as those set forth, but the values achieved by Sherman et al. are significantly different than Applicant's. Regarding claims 35, 36, 42, 43, and 49-51, Sherman et al. do not teach or disclose a primer layer of the instantly claimed composition.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

Art Unit: 1712

which applicant regards as the invention. The claim language "wherein the processing aid is transient" is not clear. The specification does not provide any examples of a transient compound, and therefore it is not clear to what a transient compound pertains.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims ~~1~~¹⁻², 8-24, 27-34, 37-41, 44-48, and 52-63 are rejected under 35

U.S.C. 103(a) as being unpatentable over Sherman et al. (WO 96/34028) in view of Flannigan (3,772,247). Regarding claims 1, 15, 16, Sherman et al. disclose a pressure sensitive adhesive (psa) comprising a tackifying silicone resin (page 8, lines 20-29 and page 19, line 5-page 10, line 13) and a polydiorganosiloxane polyurea copolymer (page 10, line 9-page 13, line 7). Sherman et al. do not appear to specifically disclose a silicone resin having no greater than about 1.5 weight percent Si-OH functional groups. Flannigan (3,772,247) discloses a psa composition comprising a silicone resin with a reduced silicon-bonded hydroxyl content of less than 1.0 percent by weight (col.1, lines 30-40) that is achieved after treatment with a triorganohalogensilane (col.2, lines 8-10) and results showing that increased amounts of triorganohalogensilane in a treatment to

Art Unit: 1712

lower the silanol content in the resin produces increased tackiness, as shown in Table 1 (col.4, lines 34-30) and Examples 1-6 of Flannigan. Further, Applicant discloses that the resin of Flannigan is acceptable in the present invention (specification, page 15, lines 2-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have lowered the silicon-bonded hydroxyl content as taught by Flannigan in the composition of Sherman et al. because Flannigan teaches that lowering the silicon-bonded hydroxyl content produces increased tackiness resulting in a higher quality product.

Regarding claim 2, although Sherman et al. do not appear to specifically disclose a high or low energy surface material. Sherman et al. disclose applying the psa composition to a variety of substrates (page 5, lines 19-29). As Applicant appears to be claiming any substrate by the claim language "wherein the psa adheres to both high and low surface energy materials as well as those in between," this appears to be included by Sherman et al.

Regarding claim 8, Sherman et al. disclose wherein the polydiorganosiloxane polyurea copolymer is the reaction product of a polydiorganosiloxane polyamine with a polyisocyanate (page14, line 4-page 16, line 30).

Regarding claim 9, Sherman et al. do not appear to specifically disclose a chain extender. However, it is the Examiner's position that chain extenders are commonly used in the art to control the molecular weight of a polymer. Therefore, it would have been obvious to one of ordinary skill in the art at the

Art Unit: 1712

time the invention was made to have added a chain extender to control the molecular weight of the polymer.

Regarding claim 10, Sherman et al. disclose the instantly claimed repeating unit (page 10, line 9-page 13, line 3).

Regarding claim 11, Sherman et al. disclose the instantly claimed limitation (page 11, lines 6-10).

Regarding claim 12, Sherman et al. disclose wherein m is a number included in the instantly claimed range (page 12, bottom of the page).

Regarding claim 13, Sherman et al. disclose a n number that is included in the instantly claimed range (page 10, line 3).

Regarding claim 14, Sherman et al. disclose a p number that is included in the instantly claimed range (page 13, line 1).

Regarding claim 17, Sherman et al. disclose wherein the silicone tackifying resin is present in an amount included in the instantly claimed range (page 20, lines 14-21).

Regarding claim 18, Sherman et al. disclose a ratio as instantly claimed (page 19, line 17, as disclosed in 5,248,739).

Regarding claim 19, Sherman et al. disclose a molecular weight as instantly claimed (page 19, lines 5-13).

Regarding claim 20, Sherman et al. disclose a plasticizer can be added (page 9, lines 21-23).

Regarding claim 21, Sherman et al. disclose a solvent based composition (page 9, lines 24-27).

Art Unit: 1712

Regarding claim 22, the same reasoning as set forth above for claims 1 and 2 also applies to claim 22, as the claimed subject matter is essentially the same.

Regarding claim 23, the same reasoning as set forth above for claims 2 and 18 also applies to claim 23, as the claimed subject matter is essentially the same.

Regarding claim 24, Sherman et al. do not appear to disclose the instantly claimed limitation. However, as set forth above, Flannigan discloses that decreased silanol content results in increased tackiness (Examples and Table 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a greater initial peel performance in the combination of Sherman et al. on a variety of substrates, including those s instantly claimed, because the combination teaches that reduces silanol content produces increased tackiness.

Regarding claim 27, the same reasoning as set forth above for claim 20 also applies to claim 27, as the claimed subject matter is essentially the same.

Regarding claim 28, the same reasoning as set forth above for claims 1, 11, and 12-14 also applies to claim 28, as the claimed subject matter is essentially the same.

Regarding claim 29, the same reasoning as set forth above for claim 1 also applies to claim 29, as the claimed subject matter is essentially the same, except for the limitation of a processing aid. Sherman et al. disclose a

Art Unit: 1712

processing aid (page 9, lines 21-23) and an organic solvent (page 24, lines 21-27).

Regarding claim 30, Sherman et al. disclose a list of possible additives, some that could be transient (page 9, lines 21-23). Because Applicant has given no examples of a transient processing aid, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a transient compound from the group of Sherman et al. because Sherman et al. teach that adding a processing aid produces a composition that permits a variety of processing methods resulting in a more versatile composition.

Regarding claims 31-33, Sherman et al. disclose the psa of claim 1 and the instantly claimed limitations (page 30, line 26-page 31, line 30).

Regarding claim 34, Sherman et al. disclose a primer layer (page 29, lines 21-27).

Regarding claim 37, Sherman et al. disclose a backing comprising acid functional groups (page 31, lines 15-18).

Regarding claims 38-40, the same reasoning as set forth above for claims 31-33 also applies to claims 38-40, as the claimed subject matter is essentially the same.

Regarding claim 41, Sherman et al. disclose a primer layer (page 29, lines 21-27).

Regarding claim 44, Sherman et al. disclose a backing comprising acid functional groups (page 31, lines 15-18).

Art Unit: 1712

Regarding claims 45-47, the same reasoning as set forth above for claims 31-33 also applies to claims 45-47, as the claimed subject matter is essentially the same.

Regarding claim 48, Sherman et al. disclose a primer layer (page 29, lines 21-27).

Regarding claims 52, 54, and 56, Sherman et al. disclose an article with the adhesive of claim 1 disposed therebetween (page 28, lines 4-13).

Regarding claims 53, 55, and 57, Sherman et al. disclose a vibration damper (page 28, lines 4-13).

Regarding claim 58, the same reasoning as set forth in claim 1 also applies to claim 58, as the claimed subject matter is essentially the same.

Regarding claim 59, the same reasoning as set forth above for claim 9 also applies to claim 59, as the claimed subject matter is essentially the same.

Regarding claim 60, the same reasoning as set forth in claim 10 also applies to claim 60, as the claimed subject matter is essentially the same.

Regarding claims 61-63, the same reasoning as set forth above for claims 15, 17, and 18 also applies to claims 61-63, respectively, as the claimed subject matter is essentially the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone

Art Unit: 1712

number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan



January 15, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700